

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 26

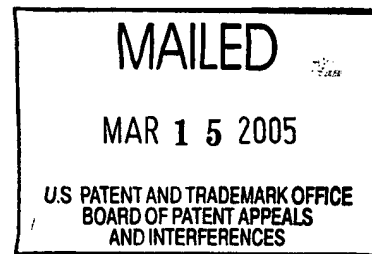
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM C. DELEEUEW

Appeal No. 2005-0062
Application 09/222,906

ON BRIEF



Before KRASS, BARRY, and MACDONALD, **Administrative Patent Judges**.
MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-19.

Invention

Appellant's invention relates to a method, system, apparatus, and set of instructions in a storage medium for extracting information from a file. First, a file is

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processed with a printer driver to generate a representation of the file. Information is then extracted from the representation. Appellant's specification at page 4, lines 18-21.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method for extracting information from a file, comprising:

processing a file with a printer driver module to generate a representation having a modified format for output by a printer; and

extracting text information from said representation.

References

The references relied on by the Examiner are as follows:

Yokomizo et al (Yokomizo)	5,907,835	May 25, 1999
		(Filed November 17, 1995)

Rejections At Issue

Claims 1-5, 8-12, and 18-19 stand rejected under 35 U.S.C. § 102 as being anticipated by Yokomizo.

Claims 6-7 and 13-17 stand rejected under 35 U.S.C. § 103 as being obvious over Yokomizo.

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Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1-5, 8-12, and 18-19 under 35 U.S.C. § 102; we reverse the Examiner's rejection of claims 6-7 and 13-14 under 35 U.S.C. § 103 and we affirm the Examiner's rejection of claims 15-17 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

¹Appellant filed an appeal brief on February 9, 2004. Appellant filed a reply brief on May 10, 2004. The Examiner mailed an Examiner's Answer on March 5, 2004.

Appellant has indicated that for purposes of this appeal the claims are grouped as follows:

Claims 1-5, 8-12, and 18-19, as Group I; and

Claims 6-7, and 13-17, as Group II.

See page 4 of the brief. Furthermore, Appellant argues each group separately and explains why each group is believed to be separately patentable. See pages 5-7 of the brief and pages 1-4 of the reply brief. Appellant presents no arguments as to why any claims within Group I, are separately patentable from the other claims within that group. However, at page 4 of the reply brief the Appellant presents arguments as to why claims 6-7 and 13-14 of Group II are separately patentable from the other claims within that group. Appellant has fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are

believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellant's claims as standing or falling together in three groups, and we will treat:

Claim 1 as a representative claim of Group I (as above); and

Claim 6 as a representative claim of Group II (claims 6-7 and 13-14); and

Claim 15 as a representative claim of Group III (claims 15-17).

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. **In re McDaniel**, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). **See also In re Watts**, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1-5, 8-12, and 18-19 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Yokomizo does fully meet the invention as recited in claims 1-5, 8-12, and 18-19. Accordingly, we affirm.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 1, Appellant argues at page 6 of the brief, "the representation from which text data is extracted is not created by the printer driver but by a module that precedes the printer driver." We find Appellant's argument unpersuasive.

Appellant's argument is silent as to what module he is referencing. We have reviewed Yokomizo and fail to find any module preceding the printer driver (item 6, in figure 1). We do find a module (item 10-1) following the printer driver and preceding the key word extractor (item 10-3). However, we find nothing in Appellant's claim language that precludes having a module between the printer driver and the extractor.

At pages 2-3 of the reply brief Appellant further argues that he has "[eliminated] the need for a new common document format functionality required by Yokomizo." We have reviewed claim 1 and fail to find any such limitation.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 6-7 and 13-14 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 6-7 and 13-14. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to dependent claim 6, Appellant argues at page 4 of the reply brief that the Examiner has failed to establish that the elements of claims 6-7 and 13-14 are obvious over Yokomizo. We agree.

The Examiner's rejection at pages 5-6 of the Final rejection (Paper No. 16) states that Yokomizo fails to teach the features of claim 6. The rejection goes on to state that it would be obvious to modify Yokomizo to include these features, as these features are well known. We find that Appellant has not challenged the Examiner's taking of official notice as to these features. However, we also find that the Examiner has used improper hindsight to combine the well-known features with the system of Yokomizo. Mere existence in the prior art is not

sufficient motivation to combine. The Examiner has not met the initial burden of establishing a **prima facie** case of obviousness.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

**III. Whether the Rejection of Claims 15-17 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 15-17. Accordingly, we affirm.

With respect to independent claim 15, Appellant has presented no arguments as to why the Examiner has failed to properly establish a **prima facie** case of obviousness. See section B of Appellant's brief at pages 6-7 that is directed to claims 6-7 and 13-17. Section A of Appellant's brief is directed to independent claims 1, 8, and 18. Section B refers back to the arguments of section A, but lists the independent claims as 1, 8, and 15. The result is that there are no arguments with respect to claims 15-17.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.


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Conclusion


In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claims 1-5, 8-12, and 18-19; we have not sustained the rejection under 35 U.S.C. § 103 of claims 6-7 and 13-14; and we have sustained the rejection under 35 U.S.C. § 103 of claims 15-17.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART


ERROL A. KRASS)
Administrative Patent Judge)


LANCE LEONARD BARRY)
Administrative Patent Judge)


ALLEN R. MACDONALD)
Administrative Patent Judge)

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